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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/127,112 07/31/98 MARCUS

B 005

BRIAN I MARCUS
52 DARRELL PLACE APT 1
SAN FRANCISCO CA 94133

QM12/0925

EXAMINER

ROVNAK, J

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

19
09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/127,112

Applicant(s)
Marcus et al

Examiner
John Rovnak

Group Art Unit
3713



☒ Responsive to communication(s) filed on 8/31/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 49-69 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 49-69 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. In view of the applicants response and IDS filed 8/31/00, the finality of the previous office action is withdrawn and PROSECUTION IS HEREBY REOPENED.
2. The indicated allowability of claims 49-52 is withdrawn in view of the new grounds of rejection based upon applicant's newly filed IDS and recently discovered art.
3. Applicant has canceled the previously rejected claims.
4. The terminal disclaimer filed on 2/29/00 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date has been reviewed and is accepted. The terminal disclaimer has been recorded.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 49-56 and 60-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (JP 05177056) made of record by applicant in the IDS, paper No. 17, filed 8/31/00.

In the Miyamoto et al abstract, there is disclosed a computer system comprising: a plurality of hand held objects having a unique visual aspect (dice with markings); a substantially horizontal surface (die rolling plane) including at least a section capable of supporting said plurality of hand-held objects, said section inherently having no predefined positions for supporting said plurality of hand-held objects; a detecting element and inherent processor proximate to at least said section of

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said surface (receiving coils below the die rolling plane); an inherent computer with output device, with stored executable code for the processing of information relating to the identification of said visual aspect; and a component within said hand-held object capable of affecting an electrical change in a portion of said detecting element. The abstract of Miyamoto et al does not discuss the use of a personal computer, however a computer processor is inherent and it would have been obvious to one of ordinary skill in the art that a personal computer could be used for the information processing.

Miyamoto et al discloses that "many receiving coils for receiving the electromagnetic wave signals transmitted from the identification number transmitting tags 20 buried on a die 10 are provided below a die rolling plane". Use of a wire grid and a plurality of electrically conductive wires would be obvious if not inherent in the Miyamoto et al coil network.

The Miyamoto et al unique visual aspect comprises a picture or symbol (dots). It would have been obvious to one of ordinary skill in the art that a numeric character could replace the number of dots, and furthermore that a unique color could also replace the dots as an indicator of dot number, such modifications being a choice of artistic design and not patentably limiting.

7. Claims 49, 51, 57-59, 61 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al (4,550,250).

8. Mueller et al discloses a hand held object having a unique visual aspect and component exhibiting a characteristic representing said visual aspect, a substantially horizontal surface for

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object support, a detecting element proximate to said surface capable of detecting said characteristic of said component, a processor linked to said detecting element (computer 8) said processor being capable of identifying a position of said hand-held object on said surface. Mueller et al uses triangulation for position detection. Applicant claims one object of a plurality detection capability. It would have been obvious that a plurality of other hand-held objects of any kind could be included with the system of Mueller.

9. Mueller et al demonstrates the use of wireless communication. The link (12) in Fig. 1 between detection system and personal computer is a hard wire. It would however have been obvious to one of ordinary skill in the art that wireless technology could be used for said link.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 58 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 58 is directed to a link to a personal computer from another computer system that comprises a personal computer (in claim 49). Claim 67 is directed to a personal computer link from a computer system without a personal computer in claim 52. Both claims are indefinite as to the purpose of another computer link and suggest confusing multiple imbedded computer systems.

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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the hand held objects of French et al (5,651,548) for use on a horizontal surface with detectors. See the position tracked bodies of Zalewski (5,991,693) and wireless system of Russell (5,481,265). Applicant's disclosure of "Graspable User Interfaces" by George W. Fitzmaurice (doctoral thesis) 1996, pages 35-37 discloses the "LegoWall" apparatus which reads upon applicant's claims. No date is provided for the development by Kund Molenbach of Scaitech and LEGO) but is assumed to predate the Fitzmaurice document. Applicant has further indicated in the after-final IDS that the parent of the present application, U.S. Patent No. 5,823,782 is currently involved in a patent infringement litigation. Any pertinent prior art involved in said litigation and not already disclosed is required in the next response.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rovnak whose telephone number is (703) 308-3087.


John Edmund Rovnak
Patent Examiner

9/2/00